

Notice of Allowability

Application No.

09/890,186

Examiner

Venkataraman Balasubramanian

Applicant(s)

ADAMS ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/29/2003.
2. ☒ The allowed claim(s) is/are 1-18, 29 and 34-36.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 12/29/2003
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Applicants' response filed on 08/29/2003 and supplemental response filed on 12/29/2003, are made of record. Claims 1-18, 29, and 34-36 are pending.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

In view of applicants' response, all 112 second paragraph rejections made in the previous office action have been obviated. Similarly, in view of applicants' amendment to claim 1 limiting to specific variable groups and providing a Declaration of Nathaniel Monck under 37 CFR § 1.132, all prior art 102/103 rejections made in the previous office action have been obviated. More specifically, the declaration In response to prior art 103 rejections over Mokrosz, over Jonas in view of Mokrosz and over Bos in view of Mokrosz, applicants have shown unobvious results by providing a declaration from Nathaniel Monck which compares side by side the closest prior art compound with the instantly claimed compounds. As can be seen from the Table 1 and Table 2, shown in the declaration, the instant compounds show much higher 5-HT_{2c} activity as compared to the prior art compound. Thus the declaration establishing significantly higher 5-HT_{2c} activity for the instantly claimed compounds is deemed sufficient to overcome the rejection under 35 U.S.C. 103(a) rejections applied in the previous office action. The Instant claims are therefore deemed to be novel and patentably distinct.

The tricyclic piperazine compound of formula I, with specific X₁, X₂, X₃, X₄ R₁, R₂, R₃, R₄, R₅, R₆, and R₇ groups, process of making, composition, and the method of use to treat obesity embraced in the instant claims was not found to be anticipated or

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rendered obvious by the prior art of record. Additional search in the related art area also did not yield any prior art disclosing the tricyclic piperazine compound of formula I, with specific X_1 , X_2 , X_3 , X_4 , R_1 , R_2 , R_3 , R_4 , R_5 , R_6 , and R_7 groups, process of making, composition, and the method of use to treat obesity embraced in the instant claims. Therefore, the examiner noted that the claims 1-18, 29, and 34-36 would be in condition for allowance.

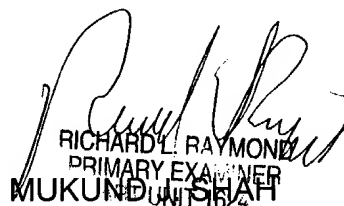
Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (571) 272-0674. If Applicants are unable to reach Mukund Shah within 24-hour period, they may contact James O. Wilson, Acting-SPE of art unit 1624 at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

VB

V. Balasubramanian

4/14/2004



RICHARD L. RAYMOND
PRIMARY EXAMINER
MUKUND U. SHAH
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SUPERVISORY PATENT EXAMINER

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